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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,796	07/11/2005	Alexandre Muller	1811-61	8248

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EXAMINER

O CONNOR, CARY E

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/518,796

Applicant(s)

MULLER ET AL

Examiner

Cary E. O'Connor

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 16 20-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 14, 15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Goedhart (2,618,796). Goedhart shows instrumentation comprising two levers 10, 11 connected to each other in a rotating and non-crossing manner, by an articulation 15. Each of the levers being comprised of a handle 10d, 11d and an arm 10f, 11f, wherein bringing the handles together causes the arms to separate. The end 10g, 11g of the arms are curved and are comprised of tips 28, 29 positionable in a detachable way and with a rotational capacity at the ends. As to claims 14 and 15, note the mechanisms 18, 19, 20 for subjecting the arms to the action of progressive separating forces. As to claim 19, note that the tip includes a cylindrical rod 23 received in a bore in the arms.

Claims 12, 15 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Unsinger et al (544,268). Unsinger shows instrumentation comprising two levers 1, 1 connected to each other in a rotating and non-crossing manner, by an articulation 3. Each of the levers being comprised of a handle and an arm, wherein bringing the handles together causes the arms to separate. The end 4 of the arms are curved and are comprised of tips 6 positionable in a detachable way and with a rotational capacity

at the ends. As to claims 15 and 22, note the leaf spring 2a which permits automatic return of the arms into a position close together.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 13, 15, 17, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over King (4,571,808) in view of Mayer (5,537,727). King shows instrumentation comprising two levers connected to each other in a rotating and non-crossing manner, by an articulation 34. Each of the levers being comprised of a handle 14, 16 and an arm, wherein bringing the handles together causes the arms to separate. The arms are curved and are comprised of tips 22, 24. King does not show the tips positionable in a detachable way and with a rotational capacity at the ends of the arms. Mayer shows an apparatus comprising handles and arms and tips 132, 136 rotatably and detachably connected to the arms so that the tips can be interchanged and adjusted relative to the arms. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the tips of King so that they are rotatably and detachably connected to the arms, as taught by Mayer, so that the tips can be interchanged or rotatably adjusted for ease of handling. As to claims 13, 17 and 18, note the notch 44, 46 of King which is defined by a planar support surface of the tip and

is generally V-shaped. As to claims 15 and 22, note the leaf spring 40, 42 which permits automatic return of the arms into a position close together.

Allowable Subject Matter

Claims 16, 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed January 17, 2006 have been fully considered but they are not persuasive. In response to applicant's argument that the Unsinger device is used to enlarge tube or openings, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Further, with respect to applicant's arguments that the tips of Unsinger and Goedhart are not in the form of clamps. "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips v AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc). *Sunrace Roots Enter. Co. v SRAM Corp.* 336 F3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003). The ordinary and customary meaning of a term may be evidenced by a variety

of sources, *Phillips v AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc), including the claims themselves, *Process Control Corp. v HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999); dictionaries and treatises, *Tex. Digital Sys., Inc. v. Telegenix, Inc.* 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002). The American Heritage® Dictionary of the English Language, Fourth Edition, defines "clamp" as "1. Any of various devices used to join, grip, support, or compress mechanical or structural parts. 2. Any of various tools with opposing, often adjustable sides or parts for bracing objects or holding them together." The tips of Unsinger brace the tubes and the tips of Goedhart brace the eyeglass frames and are considered clamps. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Unsinger's and Goedhart's ends are not in the same orientation as applicant's ends and the tips are not U-shaped) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In response to applicant's argument that Unsinger's and Goedhart's instruments are not intended to be engaged between the crest of the root and the root post, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference

as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cary E. O'Connor
Primary Examiner
Art Unit 3732